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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,955	10/11/2001	John C. Murray	P 283374 HT-3046 CIP2	7402
909	7590	02/26/2004	EXAMINER	
PILLSBURY WINTHROP, LLP P.O. BOX 10500 MCLEAN, VA 22102			REIS, TRAVIS M	
			ART UNIT	PAPER NUMBER
			2859	
DATE MAILED: 02/26/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/973,955

Applicant(s)

MURRAY, JOHN C.

Examiner

Travis M Reis

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

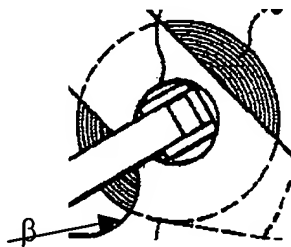
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 22, 24, 25, 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (U.S. Patent 4527334) in view of Bayerische (DE 3621368A1) & Choi (U.S. Patent 5544420).

With reference to claims 22, 24, 25, & 29-31, Jones et al. discloses a retractable rule assembly (10) comprising a housing assembly (11); a reel (26) rotatably mounted in said housing assembly; an elongated blade (17) formed of a ribbon of metal having one end connected to said reel, said blade extendable from a position tangential to said reel outwardly through a spaced opening in said housing assembly, said elongated blade having measuring indicia (Figure 4) formed on the upper side thereof, and a clear, plastic, protective coating (col. 2 lines 63-64) provided on both sides of said blade throughout the length of the blade for inhibiting wear of said measuring indicia; a coil spring (31) formed of a ribbon of metal constructed to rotate said reel in said housing assembly in a direction to wind up the elongated blade when extending outwardly of said housing assembly onto said reel in an abutting volute coil formation in a flattened cross-sectional configuration (col. 3 lines 14-15), and a blade holding assembly (23) constructed to hold the blade in any position of extension outwardly of said housing assembly opening and to release the blade from any position in which it is held.

Jones et al. do not disclose a relatively short free end portion of said blade having a film of plastic material overlying a protective coating on at least one of the convex and concave sides of the blade, the film of plastic material extending across 100% of the blade width, with the film of plastic material having measuring indicia formed thereon, the film extending on said free end portion of said portion to a position of said blade that has been wrapped around said reel, said film extending between said end hook member and said blade such that said film extends underneath said end hook member.

Bayerische discloses a measuring tape with a thick film of plastic material (9) (Figure 6) provided on both sides overlying a blade (4) and said film extending across 100% of the blade width of the measuring tape having to prevent kinking of the end of the blade (Figure 3) said film also having measuring indicia formed thereon (col. 4 lines 31-32); the film just extending on said free end portion of said portion to a position of said blade that has been wrapped around said reel ( $\beta$ , see below);



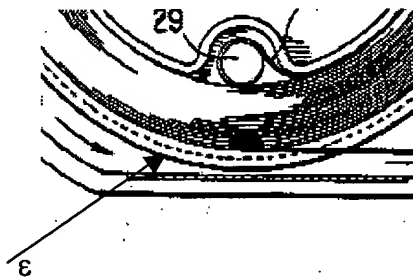
and said film extending between an end hook member (7) and said blade (Figure 3) such that said film extends underneath (13) said end hook member (Figure 4). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the film of plastic material disclosed by Bayerische to the blade disclosed by Jones et al. in order to prevent kinking of the end of the blade & to see measuring indicia.

Jones et al. & Bayerische do not disclose the film of plastic material having a thickness greater than a thickness of the protective coating. However, to choose a film of plastic material thicker than the plastic coating, absent any criticality, is only considered to be an “

Art Unit: 2859

optimum " value of the film of plastic material and the protective coating, as stated above, that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired accuracy and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 ( CCPA 1980 ).

Jones et al. discloses said film having a longitudinally curved portion along a longitudinal direction of said blade when fully retracted within said housing assembly ( $\epsilon$ , see below)



Jones et al. & Bayerische do not disclose said elongated blade housing a concave-convex configuration when extended from said housing assembly.

Choi discloses a combination tape measure and light bulb with a measuring blade (12) in a concavo-convex configuration when extended from said housing assembly (Figure 5) and also has a longitudinally curved portion along a longitudinal direction of said blade (Figure 1). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to pre-form the blade disclosed by Jones et al. and to pre-form and mold the film disclosed by Bayerische in the manner taught by Choi. since a measuring tape in a concavo-convex configuration and having a longitudinally curved portion along a longitudinal direction of said blade is well known in the art to keep the blade straight and prevent drooping when extended.

Art Unit: 2859

With reference to claim 32, Jones et al., Bayerische, & Choi do not disclose said film extends across less than one hundred percent of the width of said blade. However, the shape of the film, i.e. extending over less than one hundred percent of the width of said blade, absent any criticality, is only considered to be obvious modifications of the shape of the film disclosed by Jones et al., Bayerische, & Choi as the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by Applicant and is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide using routine experimentation based on its suitability for the intended use of the invention and the interest of conserving material. See *In re Dailey*, 149 USPQ 47 ( CCPA 1976 ).

3. Claims 4-14, 17-21, 23, & 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al., Bayerische, Choi, as applied to claims 22, 24, 25, & 29-32, above, and further in view of Bradshaw et al. (U.S. Patent 4900392).

With reference to claims 4, 13, 17, 18, 23, & 26-28, Jones et al., Bayerische, & Choi, disclose all of the instant claimed invention as stated above in the rejection of claims 22, 24, 25, 29-32 including said film extends from the free end of the blade to approximately the point where the blade is in said abutting volute configuration when said blade is fully retracted (Bayerische Figure 3).

Jones et al., Bayerische, & Choi, do not disclose expressly said film selected from said group is secured to said plastic coating with an acrylic adhesive.

Bradshaw et al. discloses a slidable indicia alignment and transfer device that uses an acrylic adhesive which is common to the art of securement (col. 4 lines 27-39). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to use the acrylic adhesive taught by Bradshaw et al. to secure the film to the coating

Art Unit: 2859

taught by Jones et al., & Bayerische in order to keep the film secured to the coating and thus the blade during use.

With reference to claims 5 & 9, Jones et al., Bayerische, Choi, & Bradshaw disclose all of the instant claimed invention as stated above in the rejection of claims 22, 24, 25, & 29-32, but do not disclose expressly that the length of the portion of the blade covered by said film is approximately 2 inches to approximately 12 inches. However, to choose a length of approximately 2 inches to approximately 12 inches for the length of the film, absent any criticality, is only considered to be the " optimum " value of the length of the film, as stated above, that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired accuracy and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 ( CCPA 1980 ).

With reference to claims 6 & 8, Jones et al., Bayerische, Choi, & Bradshaw disclose all of the instant claimed invention as stated above in the rejection of claims 22, 24, 25, & 29-32, but do not disclose expressly that said film has a thickness dimension within a range of 0.006" to 0.014". However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the film having a thickness of between .0006" - .0014", since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the "optimum range" involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

With reference to claims 7 & 9, Jones et al., Bayerische, Choi, & Bradshaw, disclose said retractable rule further comprises an end hook member formed of sheet metal of a predetermined thickness to include a concavo-convex mounting portion (21) and a U-shaped hook portion (20) that is broadly considered to be bent (Jones Figure 4) at a broadly right

Art Unit: 2859

angular position from an end (19) of said mounting portion (i.e. U shaped hook portion will be held at a generally right angle, especially when the tape measure is held level), and said end hook member being mounted on the free end of said blade with the mounting portion of said hook member being secured for limited movement with respect to the free end of the blade so that said rule can be measured externally from an exterior surface of said U-shaped hook portion or internally from an interior surface of said U-shaped hook portion (Jones Figures 1 & 4).

With reference to claims 10-12, Jones et al., Bayerische, Choi, & Bradshaw disclose all of the instant claimed invention as stated above in the rejection of claims 22, 24, 25, & 29-32, including said housing opening has a height dimension which exceeds the height dimension of a hook member mounting portion and its connection with the free end of said blade an amount which is at least approximately equal to the amount a hook portion (20) extends below said bottom end surface of said housing assembly when at said housing opening (Jones Figure 4); and the lateral edges of said mounting portion adjacent said hook portion provide upwardly facing surfaces (18) which engage one or more downwardly facing surfaces (Jones Figure 4) defining the housing opening to limit the upward movement of said hook member within said opening (Jones Figure 3).

With reference to claim 14, Jones et al, Bayerische, Choi, & Bradshaw disclose all of the instant claimed invention as stated above in the rejection of claims 22, 24, 25, & 29-32, but do not disclose that said film of plastic material comprises a plurality of layers of plastic material. However, Official notice is taken with respect to the plurality of layers of plastic material since it is very well known in the art to use a plurality of layers of plastic material to increase the strength & durability of the plastic material. Thus, to include a plurality of layers of plastic material disclosed by Jones et al, Bayerische, Choi, & Bradshaw would have been



Art Unit: 2859

obvious to a person having ordinary skill in the art at the time the invention was made since the plastic material will be greater subject to wear with merely one layer of material.

With reference to claim 19, Although Jones et al. do not disclose the protective coating comprises a plastic material having a thickness dimension less than about .0035", it is inherent that the protective coating has a thickness, To choose a thickness of 0.0035" or less for the protective coating disclosed by Jones et al., absent any criticality, is only considered to be the " optimum " value of the thickness of the coating disclosed by Jones et al., as stated above, that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired manufacturing costs and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 ( CCPA 1980 ).

With reference to claim 20, Jones et al., Bayerische, Choi & Bradshaw disclose all of the instant claimed invention as stated above in the rejection of claims 22, 24, 25, & 29-32, including a layer of painted indicia between said blade and said protective coating (col. 2 line 64).

Jones et al., Bayerische, Choi, & Bradshaw do not disclose said layer of paint having a thickness of between .0006"-.0014". However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide a layer of paint having a thickness in the range of .0006"-.0014", since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the "optimum range" involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

With reference to claim 21, Jones et al., Bayerische, & Choi disclose all of the instant claimed invention as stated above in the rejection of claims 22, 24, 25, & 29-32, but do not disclose that said protective coating is formed from a material selected from the group

Art Unit: 2859

consisting of polyamides, polyvinyl, polyesters, silicone, polyimides, polyethylene, fluoropolymers and polyethylene terephthalate. However, the particular type of material used to make the protective coating, absent any criticality, is only considered to be the use of a "preferred" or "optimum" material out of a plurality of well known protective coating materials that a person having ordinary skill in the art at the time the invention was made would have found obvious to provide using routine experimentation based, among other things, on manufacturing costs the intended use of Applicant's apparatus, i.e., suitability for the intended use of Applicant's apparatus, and since the courts have stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious. See In re Leshin, 125 USPQ 416 (CCPA 1960).

4. Claims 15 & 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al., Bayerische, Choi & Bradshaw as applied to claims 4-13, 17-21, 23, & 26-28 above, and further in view of Beeber (U.S. Patent 2994958).

Jones et al., Bayerische, Choi, & Bradshaw disclose all of the instant claimed invention as stated above in the rejection of claims 4-13, 17-21, 23, & 26-28 but do not disclose the film of plastic material comprises at least one fiber reinforcing member.

Beeber discloses measuring tape with a film of plastic material (8) with filament reinforcing members (10) which can be made of fibers such as polyester (col. 2 lines 53-56) (Figure 2). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the filament reinforcing members disclosed by Beeber to the film of plastic material in order to increase the strength of the film during use.

### ***Response to Arguments***

5. Applicant's arguments filed that Jones et al, Bayerische, & Choi, with respect to claims 22, 24, & 29 do not provide a longitudinally curved portion along a longitudinal direction of

Art Unit: 2859

said blade when fully retracted within said housing assembly have been fully considered but they are not persuasive, since a longitudinal curved portion along a longitudinal direction is common in a measuring tape surrounding a reel as detailed in paragraph 2, and though Bayerische discloses that the fitting does not adjust to the curve of the winding, when Bayerische is combined with Jones, it is capable of curving. That the Bayerische device was designed to not be subjected to bending alternating stresses does not preclude all alternating bending stresses from being encountered, and since the fitting disclosed by Bayerische in fact is designed to reduce all stresses encountered, including any bending alternating stresses, this would provide additional motivation to one in the art seeking to combine Jones et al. & Bayerische.

6. Applicant's arguments filed with respect to claims 25 & 30 that Bayerische does not have a free end portion of said blade to a position on said portion of said blade that has been wrapped around said reel and therefore inappropriate to be combined with Jones et al.; these arguments have been fully considered but they are not persuasive since a small increment of said free end of said fitting is a part of the portion of said blade that has been wrapped around said reel as illustrated above in paragraph 2, even though it does not extend into the winding; therefore showing appropriateness to combine with Jones et al.

7. Applicant's arguments filed with respect to claims 3-12 and 1-32 as a whole that the rejection of said claims is improper due to the use of Bayerische in combination with Jones et al. and Choi (i.e. being subjected to bending), these have been fully considered but they are not persuasive since the arguments referring to the properness of the use of Bayerische (i.e. being subjected to bending) has been covered above in the preceding paragraphs.

8. Applicant's arguments filed that Choi discloses nor suggest any type of performing or molding, these arguments have been fully considered but they are not persuasive, since the

Art Unit: 2859

suggestion to pre-form a blade in a convex-concave configuration is inherent in the structure of Choi as seen in its figures, in that the blade must have been formed into a convex-concave configuration by some process.

9. Applicant's arguments filed with respect to claims 7 & 9 that Jones et al. do not illustrate a hook portion that is bent generally at a right angle; these arguments have been fully considered but they are not persuasive, since, in a broad sense, the two parts (i.e. ring (19) and hook (20)) being movable means that the hook portion is bendable in not only a generally 90 degree angle, but is bendable in a wide range of angles.

10. Applicant's arguments filed with respect to claim 9 that this is not disclosed or suggested in the prior art, these arguments have been fully considered but they are not persuasive since this feature has been addressed in paragraph 4.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis M Reis whose telephone number is (571) 272-2249. The examiner can normally be reached on 8--5 M--F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for all communications.

Travis M Reis  
Examiner  
Art Unit 2859



Diego Gutierrez  
Supervisory Patent Examiner  
Technology Center 2800

tmr  
February 23, 2004

**CHRISTOPHER W. FULTON  
PRIMARY EXAMINER**